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EXAMINER

NIGH, JAMES D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,354	Applicant(s) CHEN ET AL.	
	Examiner JAMES D. NIGH	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendments and remarks filed on 27 February 2009. Claims 1-35 have been cancelled and claims 36-68 have been newly added. Claims 36-68 are pending and are presented for examination on the merits.

Response to Amendment

2. Examiner notes that while Applicant cancelled all of the previous claims and filed new claims that the claim limitations are essentially the same as the ones examined in the prior office action. Examiner respectfully submits to Applicant that it would have been more beneficial to the prosecution of the case to either explicitly describe why and how the claimed invention differs from the prior art or to claim matter that was not recited in the prior office action. As such Examiner sees no basis for modifying the original findings of the prior office action as Applicant appears only to have reordered the same elements in the newly presented claims.

Response to Arguments

3. Applicant's argument with respect to the teachings of the 845 and 570 combination have been fully considered but are not persuasive. Examiner respectfully suggests that Applicant should have more thoroughly reviewed the teachings of the 845 and 570 combination prior to preparing Applicant's remarks. Applicant claimed a grace period in the prior office action to which the Examiner cited paragraphs 0036-0038 of the 570 reference which teaches "software may indicate that payment is due, and rather than immediately reboot and switch the user into limited operating mode, some number of warnings may be provided, during which the user can make a payment and not lose

his or her current work. Step 314 gives the system this option, with step 316 representing the hard reset, or step 318 representing handling the problem detection otherwise, e.g., via a warning prompt by which the user may be able to switch the boot path data back to normal for the next boot. Note further that even if not resolved, the device can simply wait for the next boot rather than forcing a reboot, or can force a reboot after some time, such as to give a two-hour warning". Examiner believes that a person of ordinary skill in the art would deem this to be a grace period. In the Applicant's remarks a simple statement was made that "845 however does not seem to disclose enabling the use of a system based on determining a grace period. 570 does not seem to disclose determining a grace period". The citation of 570 clearly defines what a person of ordinary skill in the art would deem to be determining a grace period and 845 discloses enabling a system. Applicant provided no argument as to why this would not be the case. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 36-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

7. Claim 36 recites a processor and then recites the steps of enabling and determining. As the steps as recited do not impose any structural modifications upon the processor but merely recite a method of use claim 36 is a hybrid claim which has been held to be indefinite "It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved", *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

8. Claim 37 recites the steps of halting and determining and is also a hybrid claim.

9. Claim 38 recites the steps of checking and determining and is also a hybrid claim.

10. Claim 39 recites the steps of disabling and determining and is also a hybrid claim.

11. Claim 40 recites the steps of halting and determining and is also a hybrid claim.

12. Claim 41 recites the steps of enabling and determining and is also a hybrid claim.

13. Claim 42 recites the steps of enabling and determining and is also a hybrid claim.

14. Claim 43 recites the steps of enabling and determining and is also a hybrid claim.

15. Claim 44 recites the steps of enabling and determining and is also a hybrid claim.

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16. Claim 45 recites the steps of enabling and determining and is also a hybrid claim.
17. Claims 37-45 are also rejected as being dependent upon claim 36.
18. Claim 54 recites the steps of enabling and determining and is also a hybrid claim.
19. Claim 57 recites the steps of requesting and determining and is also a hybrid claim.
20. Claim 58 recites the steps of checking, issuing and determining and is also a hybrid claim.
21. Claim 59 recites the steps of checking and receiving and is also a hybrid claim.
22. Claim 60 recites the steps of disabling and determining and is also a hybrid claim.
23. Claims 55-60 are also rejected as being dependent upon claim 54.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 36-53 and 57-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al. (U.S. Patent PG Publication 2006/0106845, hereinafter referred to as 845) in view of Frank et al. (U.S. Patent PG Publication 2007/0136570, hereinafter referred to as 570).**
26. As per claim 36

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845 discloses a storage device to store first information that indicates whether the system is allowed to be used (0014-0016, 0018-0020);

845 discloses reviewing payment information (0014-0016, 0018-0020, 0024-0029, 0032-0036);

845 does not explicitly disclose enabling the processor or a grace period.

570 teaches enabling the processor (0036-0038).

570 teaches a grace period (0036-0038)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for computer-based local generic commerce and management of stored value of 845 with the computing device limiting mechanism of 750 for the purpose of making a computing device resilient to modifications.

27. As per claim 37

845 discloses determining corruption (0036-0038)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an

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obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches halting the system (0036-0038)

28. As per claim 38

845 discloses the processor further checks new expiration date has been obtained based on a payment status of the system, in response to determining that the first license has expired (0027, 0040, 0045-0051).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

29. As per claim 39

845 teaches determining that the new information is unavailable (0034-0035, 0044-0048)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the

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art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches halting the booting (0036-0038).

30. As per claim 40

570 teaches halting the system (0036-0038)

570 teaches a grace period (0036-0038)

31. As per claim 41

845 discloses wherein the processor further enables the use of the system, in response to determining that a new usage is available (0027, 0034-0035, 0044-0048, 0052-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an

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obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

32. As per claim 42

845 discloses wherein the processor further enables the use of the system in response to determining that the information on usage is complete (0027, 0034-0035, 0044-0048, 0052-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

33. As per claim 43

845 discloses wherein the processor further enables the use of the system in response to determining that usage is valid (0027, 0034-0035, 0044-0048, 0052-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

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Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

34. As per claim 44

570 teaches wherein the first information comprises a license, the processor enables the use of the system, in response to determining that the first license has expired and the grace period to use the system has not expired (0036-0038).

35. As per claim 45

845 discloses wherein the processor further enables the use of the system, in response to determining that the first information is valid (0027, 0034-0035, 0044-0048, 0052-0053).

36. As per claim 46

845 discloses checking validity status that comprises usage information of a user device (0027, 0034-0035, 0044-0048, 0052-0053)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting

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that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

and 570 teaches determining whether to disable use of the user device based on the validity status of the first license and a grace period information associated with the first license (0036-0038).

37. As per claim 47

570 teaches determining if the first license has expired to obtain the validity status (0036-0038).

38. As per claim 48

845 discloses comparing a number of times the user device has been used with a value check the validity status (0035).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

39. As per claim 49

845 discloses determining availability (0027, 0034-0035, 0044-0048, 0052-0053).

845 discloses determining corruption (0036-0038)

and 845 discloses checking a validity status (0036-0038).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

40. As per claim 50

845 discloses in response to determining validity and determining availability based on a payment status associated with the user device (0027, 0034-0035, 0044-0048, 0052-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting

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that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

41. As per claim 51

570 teaches disabling the use of the user device, in response to determining that the new license is unavailable (0036-0038).

42. As per claim 52

845 discloses determining that the downloading is failed (0035)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches disabling the use of the user device, (0036-0038)

And 570 teaches the grace period has expired. (0036-0038).

43. As per claim 53

570 teaches enabling the use of the user device, in response to determining that the first license has expired and the grace period has not expired.

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44. As per claim 57

845 discloses user device further requests from the server (0017, 0024-0027, 0029, 0044-0048).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches determining that the license is invalid and the grace period has expired (0036-0038).

45. As per claim 58

845 discloses banks and payment (0017, 0024-0027, 0029, 0044-0048).

845 teaches new issue (0014-0017, 0021, 0024, 0027, 0030, 0036, 0040, 0044, 0047-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

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Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

46. As per claim 59

845 discloses integrity and validity (0036-0038).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the

art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

47. As per claim 60

845 discloses determining unavailability (0034-0035, 0044-0048)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the

art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

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Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches disabling (0036-0038).

48. As per claim 61

845 discloses payment (0017, 0024-0027, 0029, 0044-0048).

570 teaches enabling/disabling the use of the user device, (0036-0038)

And 570 teaches the grace period has expired. (0036-0038).

49. As per claim 62

845 discloses corruption (0036-0038)

845 discloses unavailability (0034-0035, 0044-0048)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

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570 teaches halting the device (0036-0038).

50. As per claim 63

845 discloses determining expiration (0027, 0034-0035, 0044-0048, 0052-0053)

845 discloses determining validity and availability based on payment status of the computing device (0027, 0034-0035, 0044-0048, 0052-0053)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036).

Software licenses that store software usage parameters are old and well known in the

art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of

Frank would have been to store the use parameters for a resource in a software license.

("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an

obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches enabling operation of the computing device (0036-0038).

51. As per claim 64

570 teaches instructions that in response to being executed result in a computing device in response to determining that the grace period has not expired, enabling operation of the computing device and issuing a warning to get a new license (0036-0038).

52. As per claim 65

845 teaches payment (0027, 0034-0035, 0044-0048, 0052-0053)

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570 teaches halting the system (0036-0038)

570 teaches a grace period (0036-0038)

53. As per claim 66

845 teaches validity (0027, 0034-0038, 0044-0048, 0052-0053)

845 teaches payment (0027, 0034-0035, 0044-0048, 0052-0053)

54. As per claim 67

845 discloses availability (0027, 0034-0035, 0044-0048, 0052-0053)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches enabling (0036-0038).

55. As per claim 68

845 discloses validity (0027, 0034-0038, 0044-0048, 0052-0053)

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the

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art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

570 teaches enabling (0036-0038).

56. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank.

57. As per claim 54

845 teaches a user device that with (0015-0017, 0021, 0024, 0027, 0030, 0036, 0040, 0044, 0047-0053). ; and

845 teaches a server that issues usage parameters for the user device based on payment status of the user device (0014-0017, 0021, 0024, 0027, 0030, 0036, 0040, 0044, 0047-0053).

845 does not explicitly teach licenses. 845 does teach storing usage parameters that are typically found in a license (0014-0016, 0018-0020, 0024-0029, 0032-0036). Software licenses that store software usage parameters are old and well known in the art (i.e. PERCs of Ginter in U.S. Patent 5892900). Therefore a predictable result of Frank would have been to store the use parameters for a resource in a software license. ("One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an

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obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

58. As per claim 55

845 teaches a network that couples the user device with the server (0014-0017, 0020, 0022, 0024, 0039-0042, 0044, 0046, 0050-0054).

59. As per claim 56

845 teaches a bank system that monitors payment status of the user device (0017, 0024-0027, 0029, 0044-0048).

Please note:

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

Conclusion

60. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685